

REMARKS

The Office Action dated September 22, 2004 has been carefully considered and, in reply thereto, applicants confirm the election to prosecute claims 1-48 and 60 in the present application. Accordingly, applicants have cancelled claims 49-59 to the non-elected invention without prejudice to the right to file a divisional application with respect thereto.

Further in reply to the Office Action, it is noted with application that the subject matter of claim 6-12, 17, 18, 20-25 and 31-41 is allowable, whereby claims 6, 17, 20, and 31 are presented herein in independent form for allowance together with claims 7-12 which are dependent from claim 6, claim 18 which is dependent from claim 17, claims 21-25 which are dependent from claim 20, and claims 32-41 which are dependent from claim 31.

Still further in reply to the Office Action, independent claims 1 and 60 are amended to more clearly distinguish applicants' invention from the prior art. For the reasons set forth hereinafter, it is respectfully submitted that claims 1 and 60 as herein amended patentably distinguish from the prior art and are allowable. Furthermore, it is respectfully submitted that the rejection of claims 26-30 is not supported by the disclosures of the prior art cited thereagainst. Accordingly, reconsideration and allowance of the remaining claims is respectfully requested.

Claims 1-3, 5, 13-16 and 19 stand rejected under 35 U.S.C. §102(b) as being anticipated by Regan. Claim 1, as amended, defines applicants' tape guide along which tape is dispensed as having an outer end, laterally opposite sides, and a central portion between and spaced below the sides for the tape guide to impart a concave contour to tape relative to the sides at the outer end of the tape guide. Regan's tape guide 90 includes a planar plate 92 along which tape T is dispensed and which corresponds to applicants' recited "tape guide," and Regan's plate 92 does not have a central portion between the sides thereof for imparting a concave contour to a dispensed tape relative to the sides

and at the outer end of the tape guide. Claims reciting a function not found in a prior art reference are not anticipated by that reference. See, *In re Mott*, 194 USPQ 305, 307 (CCPA 1977). Accordingly, it is respectfully submitted that claim 1 as amended patentably distinguishes from Regan and is allowable, together with claims 2, 3, 5, 13-16, and 19 which are dependent therefrom. Moreover, claim 5 further distinguishes from Regan by reciting ribs extending in the direction between the inner and outer ends of the arm. In this respect, the ribs of Regan referenced by the examiner extend traverse to the direction between the inner and outer ends of Regan's arm.

Claims 1, 4 and 26-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Martin in view of Samuelson. With regard first to claim 1, neither Martin nor Samuelson disclose a tape guide having a central portion for imparting a concave contour to tape being dispensed relative to the sides of the tape guide. Accordingly, neither of these patents suggest any modification of the other which would result in a tape dispenser as defined in claim 1. Claim 1, therefore, patentably distinguishes from this combination of art and is allowable, together with claim 4 which is dependent therefrom.

With regard to independent claim 26, it is respectfully submitted that the disclosure of Samuelson does not suggest or make obvious the provision of Martin with a third wall as asserted by the examiner. To begin with in this respect, the two arm portions in Samuelson are connected at the outer ends thereof by a tape guide, and the walls are flexible to facilitate the insertion and removal of a roll of tape relative to hub portions of the dispenser. In contrast, Martin discloses a rigid frame and hub structure in which one side of the dispenser is open and in which one of the arms defined by portions 20, 21 and 23 is intentionally provided with an opening 22 which, as set forth in column 3, lines 28-31, provides finger access to tape in the dispenser. There is nothing in the disclosures of either of these patents to suggest adding a third arm to Martin and which, pursuant to

claim 26, would close the open side opposite arm 17 of Martin and, accordingly, preclude finger access to tape through opening 22 as intended by Martin. It is well accepted that the mere fact that a prior art reference could be modified does not make the modification obvious unless the prior art suggests the desirability of the modification. See, *In re Gordan*, 221 USPQ 1125, 1127 (CAFC 1984). Moreover, a proposed modification for an obviousness inquiry is inappropriate when the modification renders a prior art reference inoperable for an intended purpose. See, *In re Fritch*, 23 USPQ2d 1780, 1783, note 12, (CAFC 1992) citing *In re Gordan*, *supra*.

With further regard to claim 26, the latter requires that the first and third arm portions have a tape guide therebetween which includes a central portion between and spaced below guide surfaces on the inner sides of the arm portions. Regardless of any modification one might make with respect to Martin in view of Samuelson, the resulting tape dispenser would not have applicants' tape guide structure as recited in claim 26.

For all of the foregoing reasons, it is respectfully submitted that claim 26 patentably distinguishes from the prior art and is allowable together with claims 27-30 which are dependent therefrom. With regard to claim 30, the patent to Dretzka, et al. cited thereagainst in combination with Martin and Samuelson does not overcome the shortcomings of the latter two patents.

Claims 42-44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Regan in view of Lin. Claims 42-44 are dependent from claim 1 and, therefore, patentably distinguish from Regan for the reasons set forth hereinabove with regard to claim 1. The disclosure of Lin does not overcome the shortcomings of Regan, whereby claims 42-44 are allowable over this combination of prior art.

Claims 45 and 46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Martin in view of Samuelson and further in view of Thompson, et al. Claims 45 and 46 are dependent from

claim 26 and patentably distinguish from Martin and Samuelson for the reasons set forth hereinabove with regard to claim 26. The disclosure of Thompson, et al. does not overcome the shortcomings of Martin and Samuelson with respect to claim 26, whereby claims 45 and 46 patentably distinguish from this combination of prior art.

Claims 45, 47 and 48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Martin in view of Samuelson and further in view of Lin. Claims 45, 47 and 48 are dependent from claim 26 and distinguish from Martin and Samuelson for the reasons set forth above with regard to claim 26. The disclosure of Lin does not overcome the shortcomings of Martin and Samuelson with regard to claim 26, whereby claims 45, 47 and 48 patentably distinguish from this combination of prior art.

Claim 60 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Regan in view of Niermann. As amended herein, claim 60 calls for the tape guide to have an outer end and a central portion which is arched downwardly at the outer end in a direction transverse to the opposite side of the tape guide. As pointed out hereinabove in connection with claim 1, the tape guide plate 92 of Regan which corresponds to applicants' claimed tape guide is planar in the direction transverse to the opposite sides thereof. With regard to Niermann, the outer end of the latter's tape guide is blade support 84 extending transversely between arms 80 and 82 and which includes a tape pressing surface 90 which, as is clear from Figure 2, is linear in the direction between sides 80 and 82. Niermann's tape guide further includes a twist-generating wall 74 spaced inwardly from the outer end of the tape guide and which terminates at an arcuate window defined by walls 76 and 78 of the dispenser housing components and which helps to support the tape in connection with its twisting transition of 90° from the tape roll toward the outer end of the tape guide. The arcuate slot is neither intended to nor capable of providing the tape with an arcuate contour at outer end 84 of the tape

guide. With regard to modifying Regan in view of Niermann, it is respectfully submitted that the only modification which would be suggested or obvious to one skilled in the art would be to restructure Regan to provide for the tape dispensed therefrom to translate 90° between the tape roll and a location spaced inwardly from the outer end of the tape guide. Such a modification would not provide applicants' dispenser structure as defined in claim 60. It is respectfully submitted, therefore, that claim 60 patentably distinguishes from this combination of art and is allowable.

An earnest effort has been made to place this application in condition for allowance, and reconsideration and allowance are respectfully solicited.

Respectfully submitted,

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